

DOCKET NO: 239016US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
OTTO MACHHAMMER, ET AL. : EXAMINER: OH, T. V.
SERIAL NO: 10/815,873 :
FILED: APRIL 2, 2004 : GROUP ART UNIT: 1625
FOR: HETEROGENEOUSLY :
CATALYZED PARTIAL DIRECT
OXIDATION OF PROPANE AND/OR
ISOBUTANE

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated September 17, 2007 (Answer).

Applicants note that the Examiner has withdrawn the rejection over prior art, listed as Ground (A) of the Appeal Brief (Answer at 11), even though earlier in the Answer, the Examiner states that Applicants' statement of the grounds of rejection to be reviewed on appeal is correct (Answer at 2). Since the Examiner does not discuss the prior art rejection, it is assumed that the rejection has been withdrawn. Thus, the only ground of rejection remaining is whether the enablement requirement of 35 U.S.C. § 112, first paragraph, has been satisfied.

In the Answer, while the Examiner expands somewhat on his findings with regard to the *Wands* factors made in the first Office Action (Answer at 4-10), Applicants' response thereto in the Appeal Brief is still deemed sufficient. The "(10) Response to Argument"

section of the Answer (Answer at 11-14) is essentially a repeat of the Examiner's findings of the *Wands* factors earlier in the Answer.

Whether or not catalysts are unpredictable *per se*, Applicants again point out the disclosure in the specification at page 9, lines 27-29 that, in effect, any catalyst described in the prior art for heterogeneously catalyzed partial direct oxidation of propane and/or isobutane to at least one of the target products is applicable in the presently-claimed process. Clearly, one skilled in the art would not employ a solid state catalyst that does not perform the recited partial direct oxidation. Such catalysts are necessarily excluded from the claims.

The Examiner's rationale has been rejected by case precedent. For example, as stated in *In re Goffe*, 542 F.2d 564, 191 USPQ 429, 431 (CCPA 1976):

The board suggests that the claims "would read on any liquid or solid (liquefiable under the reaction conditions) since all liquids tend to agglomerate (e.g., water, mercury, oils, etc.)." However, we disposed of a similar argument in *In re Geerdes*, 491 F.2d 1260, 1265, 180 USPQ 789, 793 (CCPA 1974), thus:

[W]e cannot agree with the board's determination that the claims are inclusive of materials which would not apparently be operative in the claimed process. *** Having stated the objective *** together with the process steps, use of materials which might prevent achievement of the objective *** can hardly be said to be within the scope of the claims.

For all practical purposes, the board would limit appellant to claims involving the specific materials disclosed in the examples, so that a competitor seeking to avoid infringing the claims would merely have to follow the disclosure in the subsequently-issued patent to find a substitute. However, to provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts." See *In re Fuetterer*, 319 F.2d 259, 265, 138 USPQ 217, 223 (1963).

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For all the above reasons, Applicants submit that the remaining ground of rejection should be REVERSED.

Respectfully submitted,

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